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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 09/882,530  | 06/15/2001  | Derrick A. Richardson | 485772003600        | 9930             |
| 7590  | 02/08/2005  |                       | EXAMINER            |                  |
| Rimas Lukas<br>P.O. Box 3295<br>Half Moon Bay, CA 94019 |             |                       | LEWIS, PATRICK T    |                  |
|   |             |                       | ART UNIT            | PAPER NUMBER     |
|   |             |                       | 1623                |                  |

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/882,530             | RICHARDSON ET AL.   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Patrick T. Lewis       | 1623                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 November 2004.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23,27,34 and 35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-23,27,34 and 35 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 15 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Invention I (claims 1-23) in the reply filed on October 21, 2002 is acknowledged.

***Applicant's Response Dated November 15, 2004***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 15, 2004 has been entered.

3. In the Response filed November 15, 2004, claims 1, 19, 21-22 and 27 were amended; claims 24-26 and 28-33 were canceled; and claims 34-35 were added. Claims 1-23, 27 and 34-35 are pending. An action on the merits of claims 1-23, 27 and 34-35 is contained herein below.

4. The rejection of claims 1-3, 5-7, 12-13, 15, 19, 23 and 27 under 35 U.S.C. 102(b) as being anticipated by Forsythe, Jr. et al. US 4,214,993 (Forsythe) is maintained for the reasons of record set forth in the Office Action dated January 15, 2004.

5. The rejection of claims 4, 10-11, 14, 16-18 and 20 under 35 U.S.C. 103(a) as being unpatentable over Forsythe in combination with BIO-RAD, Life Science Research

Products Catalog (1993), pages 57 and 60-63 (BIO-RAD) is maintained for the reasons of record set forth in the Office Action dated January 15, 2004.

***Rejections of Record Set Forth in the Office Action Dated January 15, 2004***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3, 5-7, 12-13, 15, 19, 23 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Forsythe, Jr. et al. US 4,214,993 (Forsythe).

Applicant's arguments filed November 15, 2004 have been fully considered but they are not persuasive. Applicant argues that: 1) the examiner has not clearly pointed out the second bearing surface, 2) Forsythe does not teach a filter column having a body with bearing surfaces adapted to seat on at least two collection tubes, and 3) Forsythe does not teach a filter column adapted to seat on collection tubes having differently-sized openings.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Applicant's attention is directed to the middle component shown Fig. 2 of Forsythe. The surface directly below (underneath) the rim is one bearing surface. The stem (12 shown in Fig. 1) is directly below the rim and has a smaller diameter than the rim. The surface directly below (underneath) the stem is a second bearing surface. The extraction cartridge (16 shown in Figs. 1 and 2) is directly below the stem and has a smaller diameter than the rim. The tip is directly below the

extraction cartridge (Fig. 1) and has a smaller diameter than the extraction cartridge. The tapered surface directly below the extraction cartridge is a third bearing surface. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.

8. Claims 4, 10-11, 14, 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forsythe, Jr. et al. US 4,214,993 (Forsythe) in combination with BIO-RAD, Life Science Research Products Catalog (1993), pages 57 and 60-63 (BIO-RAD).

Applicant's arguments filed November 15, 2004 have been fully considered but they are not persuasive. Applicant argues that: 1) the prior art does not teach a filter column having a body with bearing surfaces adapted to seat on at least two collection tubes and 2) the prior art does not teach the limitations recited in dependent claims 10-11, 14, 16-18 and 20.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Applicant's attention is directed to the middle component shown Fig. 2 of Forsythe. The surface directly below (underneath) the rim is one bearing surface. The stem (12 shown in Fig. 1) is directly below the rim and has a smaller diameter than the rim. The surface directly below (underneath) the stem is a second bearing surface. The extraction cartridge (16 shown in Figs. 1 and 2) is directly below the stem and has a smaller diameter than the rim. The tip is directly below the extraction cartridge (Fig. 1) and has a smaller diameter than the extraction cartridge.

The tapered surface directly below the extraction cartridge is a third bearing surface. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.

Applicant's remarks in regards to dependent claims 10-11, 14, 16-18 and 20 have been noted; however, the differences between Forsythe and the instantly claimed filter column are seen as one of design choice. BIO-RAD teaches columns within applicant's specified dimensions.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Forsythe, Jr. et al. US 4,214,993 (Forsythe).

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Applicant's attention is directed to the middle component shown Fig. 2 of Forsythe. The surface directly below (underneath) the rim is one bearing surface. The stem (12 shown in Fig. 1) is directly below the rim and has a smaller diameter than the rim. The surface directly below (underneath) the stem is a

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second bearing surface. The extraction cartridge (16 shown in Figs. 1 and 2) is directly below the stem and has a smaller diameter than the rim. The tip is directly below the extraction cartridge (Fig. 1) and has a smaller diameter than the extraction cartridge. The tapered surface directly below the extraction cartridge is a third bearing surface. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.

***Conclusion***

11. Claims 1-23, 27 and 34-35 are pending. Claims 1-23, 27 and 34-35 are rejected. No claims are allowed.

***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 571-272-0655. The examiner can normally be reached on Monday - Friday 10 am to 3 pm (Maxi Flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
\_\_\_\_\_  
Patrick T. Lewis, PhD  
Examiner  
Art Unit 1623

ptl